

### **REMARKS**

This case has been carefully reviewed and analyzed in view of the final Office Action dated 12 July 2007. Responsive to the rejections made in the final Office Action, Applicant submits remarks as follows.

In the final Office Action, the Examiner rejected Claims 1 and 3 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner stated that the Claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the Inventor(s) at the time that the Application was filed, had possession of the claimed invention.

In setting forth this rejection, the Examiner references the Amendment filed by Applicant on 18 April 2007. In that Amendment, Claim 1 was amended with Claims 2 and 4-5 being canceled. Claim 3 remained original, as filed. Briefly stated, support for the amendments found in Claim 1 is found throughout the Specification. Applicant specifically points to the Summary of the Invention, which clearly recites the claimed ranges for the embodiment of the bioactive glass/ceramic composition as recited in Claim 1.

It is to be emphasized that Claims 1 and 3 are each respectively, independent Claims. In other words, each Claim is independent of the other. The Examiner has stated that Applicant "... amended Claim 1 to include the broadest possible range of each component of the claimed ceramic." The Examiner is

partially correct in this statement. Claim 1 includes the broadest possible range for the embodiment claimed in independent Claim 1. Thus, the ranges recited in Claim 1 apply only to that Claim.

The Examiner further states that a clause in Claim 3 would not allow such to fall within the ranges in Claim 1<sup>1</sup>. It is rather peculiar that the Examiner rejects Claim 3 based on recitations in independent Claim 1 when Claim 3 is independent itself and does not depend from Claim 1. If the Examiner is confused about language presented in Claim 3, such should not be the basis for rejection of Claim 1 under 35 U.S.C. § 112, first paragraph. At the very least, Claim 1 should be allowable as the Examiner is seemingly questioning recitations presented in independent Claim 3.

Even beyond this, the “wherein” clause complained of by the Examiner is quite clear in its recitation. Independent Claim 3 specifically recites a bioactive glass-ceramic that is fabricated by mixing a first glass and a second glass.<sup>2</sup> Essentially, the first glass recited in Claim 3 is mixed with the second glass to form the bioactive glass-ceramic (“third glass”). The “third glass” will have anywhere from 10% to 90% of the first glass by weight and anywhere from 10% to 90% of the second glass by weight. For example, if 20% of the first glass is used then 80% of the second glass will be used to form the “third glass” (bioactive

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<sup>1</sup> The Examiner specifically states, “In Claim 3, another embodiment of this range is claimed wherein the “mixing ratio of the first glass to the second glass is between 90:10 and 10:90 on a weight basis.” Upon doing the calculations of first to second glass as set out in Claim 3, the amounts do not fall within the ranges as set out in Claim 1.”

<sup>2</sup> The respective compositions of the first glass and the second glass are recited in independent Claim 3.

glass-ceramic). This example reflects the intended meaning of the complained of “wherein” clause recited in Independent Claim 3.

Thus, Application respectfully submits that Claims 1 and 3 comply with under 35 U.S.C. § 112, first paragraph and specifically claim subject matter which is described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the Inventor, at the time that the Application was filed, had possession of the claimed invention.

Furthermore, Applicant respectfully requests the Examiner to remove the finality of the Office Action, as such improperly rejects independent Claim 1 for no justifiable and supported reasoning.

It is respectfully submitted, that the subject Patent Application has been placed in condition for allowance, and such action is respectfully requested.

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Reply to Office Action dated 12 July 2007

No fees are believed to be due with this Amendment. If there are any charges associated with this filing, the Honorable Commissioner for Patents is hereby authorized to charge Deposit Account #18-2011 for such charges.

Respectfully submitted,  
For: ROSENBERG, KLEIN & LEE

A handwritten signature in cursive script, appearing to read "Morton J. Rosenberg".

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